

### REMARKS

Claims 1-9, 13-22 and 26 were previously pending, of which claims 2 and 15 have been canceled; therefore, claims 1, 3-9, 13-14, 16-22 and 26 are currently pending. Reconsideration and allowance of all pending claims are respectfully requested in light of the foregoing amendments and following remarks.

#### Rejections under 35 U.S.C. §103

Claims 1, 3-8, 13-14, 16-21 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,513,159 to Dodson (hereinafter "Dodson") in view of U.S. Patent No. 5,577,244 to Killebrew (hereinafter "Killebrew"). Claims 9 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dodson in view of Killebrew and further in view of U.S. Patent Publication No. 2002/0100035 to Kenyon (hereinafter "Kenyon"). Applicants respectfully traverse the Examiner's position for the following reasons.

As the PTO recognizes in MPEP §2142:

. . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. . .

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

**1. Even when combined, the references do not teach the claimed subject matter.**

The cited references cannot be applied to reject independent claims 1 and 14 under 35 U.S.C. §103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 1, as amended, recites, in part: in response to identifying incompatible factory installed software, the program prompting the target system for an approval to uninstall the incompatible software

It will be noted that this element was previously included in dependent claim 2, which has been canceled. In rejecting claim 2, the Examiner cited Fig. 4 and column 4, lines 13-23 of Dodson as teaching this element. The cited text of Dodson is reproduced below in its entirety:

FIG. 4 is a flowchart showing the overall operation of the installation program of FIG. 2. In FIG. 4, at block 405, the master installer checks the hardware and driver evaluation. At decision point 410, the user is presented with the results of the hardware and driver evaluation. This allows the user to prevent the driver installation from happening if the user feels that the hardware and driver

evaluation is incorrect. If the user approves the installation, then at decision point 415 the master installer checks to see if all the drivers in the stack are installed. If some required drivers are not installed, then at block 420 the missing drivers are installed.

The Examiner characterizes the cited text as teaching the program prompting the user "for approval to install the driver upgrade or uninstall the incompatible software" (emphasis added). Applicants respectfully traverse the Examiner's characterization and submit that the cited text is totally devoid of any teaching or suggestion of uninstalling incompatible software responsive to approval to do so. At most, the text teaches enabling a user to prevent installation of certain software onto the target system; this is clearly not equivalent to uninstalling software that is already installed on the target system and that has been identified by the upgrade preparation program as being incompatible with the new operating system, as required by claim 1. Clearly, therefore, the combination of references fails to teach, suggest, or render obvious all of the limitations of claim 1.

In view of the foregoing, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1, as well as claims 3-9 and 13 dependent therefrom, under 35 U.S.C. §103 should be withdrawn and those claims allowed.

Claims 14, 16-22 and 26 include limitations similar to those of claims 1, 3-9 and 13; therefore, for at least the same reasons as set forth above with reference to claim 1, the rejection of claims 14, 16-22 and 26 under 35 U.S.C. §103 should be withdrawn and those claims allowed.

## **2. The combination of references is improper.**

Assuming, *arguendo*, that when combined, the references teach the claimed subject matter (which is clearly not the case, as demonstrated above), there is another, mutually exclusive, and compelling reason why the references cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides:

. . . The examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Dodson nor Killebrew teaches or even suggests the desirability of combining elements of an automatic installation program, as taught by Dodson, with a method

of updating a software program, as taught by Killebrew. Clearly, neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of any of the independent claims.

The MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

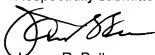
In this context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the independent claims. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

### **Conclusion**

For at least the reasons set forth in detail above, independent claims 1 and 14 are deemed to be in condition for allowance. Claims 3-9, 13, 16-21 and 26 depend from and further limit independent claims 1 and 14 and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

Respectfully submitted,



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